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No. 98-1500

IN THE
Supreme Court of the United States
OCTOBER TERM, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,
Petitioners,

v.

MATTHEW BENDER & COMPANY, INC.
and HYPERLAW, INC.,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit

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BRIEF OF RESPONDENT MATTHEW BENDER & COMPANY, INC.

DAVID NIMMER
MORGAN CHU
ELLIOT BROWN
Counsel of Record
PERRY GOLDBERG
IRELL & MANELLA LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, California 90067
(310) 277-1010

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

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QUESTIONS PRESENTED

Matthew Bender & Co., Inc. ("Bender") publishes on CD-ROM a compilation of state and federal judicial opinions. For those opinions that are published in West Publishing Co.'s ("West") reporters, Bender has included parallel citations (initial page citations) and star pagination references (citations to intermediate pages) to indicate where the text of those opinions are located in West's reporters. West concedes Bender's use of parallel citations to West's reporters does not infringe West's copyright. However, West contends Bender's use of star pagination to West's reporters infringes West's copyright. The questions presented are as follows:

1. Whether the page break locations, and the corresponding page numbers, of a book in which a literary work has been embodied are merely accidental features of the physical object in which the work is embodied, not elements of the work itself and, in any event, fail to constitute an original element of the work warranting copyright protection.

2. Whether the use of star pagination to reference page break locations and corresponding page numbers in a compilation does not constitute a reproduction of the arrangement of that compilation.

3. Whether the use of star pagination is non-infringing if it is conceded that the use of parallel citations is a non-infringing "fair use."

RULE 29.6 DISCLOSURE

Matthew Bender & Company, Inc. is a wholly owned subsidiary of Reed Elsevier Overseas BV, Reed Elsevier U.S. Holdings, Inc. and CBM Acquisition Parent Co. Reed Elsevier Overseas BV and Reed Elsevier U.S. Holdings, Inc. are wholly owned indirect subsidiaries of Reed Elsevier plc, which is publicly traded as Reed International plc and Elsevier NV. CBM Acquisition Parent Co. is a wholly owned indirect subsidiary of Reed Elsevier plc and The Times Mirror Co. Matthew Bender & Company, Inc. has less than a whole ownership interest in Ballantine & Sterling, Versus Law, Inc. and Webster Street Partners.

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Brandriss, *Writing in Frost on a Window Pane: E-Mail and Chatting on RAM and Copyright Fixation*, 43 J. Copyright Soc'y 237 (1996) 28
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1 Melville Nimmer & David Nimmer, *Nimmer on Copyright* § 3.03 (1999) 19, 27, 28
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BRIEF OF RESPONDENT MATTHEW BENDER & COMPANY, INC.

Respondent Matthew Bender & Company, Inc. ("Bender") respectfully prays that a writ of *certiorari* be granted to review the decision of the United States Court of Appeals for the Second Circuit in this case and that the decision be summarily affirmed.

OPINIONS BELOW

See Petition for Certiorari ("Pet.") at 1. Earlier proceedings in this case are reported at 39 U.S.P.Q.2d 1079 (S.D.N.Y. 1996) (denying West's motions to dismiss) and 37 US.P.Q.2d 1402 (S.D.N.Y. 1995) (granting Bender's motion to file supplemental complaint).

JURISDICTION

See Pet. 1.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, section 8, clause 8 of the United States Constitution provides:

> The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Section 101 of the Copyright Act of 1976, 17 U.S.C. § 101, provides:

> "Literary works" are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

Section 103(b) of the Copyright Act of 1976, 17 U.S.C. § 103(b), provides:

> The copyright in a compilation . . . extends only to the material contributed by the author of such work . . . .

STATEMENT OF THE CASE

A. Overview

Bender instituted this declaratory relief suit against West Publishing Co. and West Publishing Corp. (collectively "West"), challenging West's assertion of copyright over information regarding the location of page breaks and the corresponding page numbers that are mechanically inserted into its reports of judicial opinions. HyperLaw, Inc. ("HyperLaw") intervened as a plaintiff and sought a similar declaration. Bender and HyperLaw prevailed both on summary judgment before the Southern District of New York and on West's appeal to the Court of Appeals for the Second Circuit.

The Second Circuit correctly ruled that West has no copyright in the page breaks and pagination inserted into its reporters. As discussed below, that ruling is a watershed in a decades-long struggle waged by West to inhibit competition by asserting a copyright interest in the pagination of its reporters. However, because West previously secured a contrary ruling from the Eighth Circuit, one which was recently followed by the District of Minnesota, there is no guarantee that the Second Circuit ruling will exert nationwide impact. To the contrary, it is likely that, as a practical matter, West will be able to continue to trot out the Eighth Circuit rulings in its favor in order to squelch competition. This case presents an opportunity, perhaps the only opportunity, to set to rest once and for all West's erroneous star pagination copyright claim. Bender therefore respectfully submits that a writ of *certiorari* should issue and that the Second Circuit's decision should be summarily affirmed.

B. The Controversy

Bender is one of this nation's leading publishers of legal secondary literature, including such well-known treatises as *Moore's Federal Practice, Collier On Bankruptcy*, and *Weinstein's Evidence*. Bender now offers most of its secondary literature on CD-ROM under the tradename *Authority from Bender*.

To provide better legal research tools to its users, Bender has begun to bundle collections of judicial opinions with secondary sources in *Authority from Bender*. The first such product—the "New York Product"—combines secondary literature regarding New York practice (*e.g., Weinstein, Korn and Miller CPLR Manual*) with a comprehensive collection of published and unpublished judicial opinions from the state and federal courts in New York that Bender obtained under license from LEXIS-NEXIS. The New York Product is accessed by users via FOLIO software, which enables users to search the primary and secondary materials using words and citation searches. Citations in the opinions and in the secondary literature materials have been "hot linked" so that a user can retrieve the cited text—*e.g.*, an authority relied upon by a judge or treatise author—by placing the cursor over the citation and clicking the mouse. *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 693, 697 (2d Cir. 1998), Pet. App. 6a-7a. West's paper reporters, by contrast, guide research through traditional analytic tools such as syllabi, headnotes, and key number topic designations, features that are lacking in *Authority from Bender*. 158 F.3d at 696, Pet. App. 3a-4a.

Bender's New York Product and West's reporters both contain the uncopyrightable text of judicial opinions authored by federal and state judges. However, the selection and arrangement of opinions in the two products is funda-

mentally dissimilar.[1] Bender has selected for inclusion in the New York Product all the published and unpublished decisions available via LEXIS-NEXIS from the Second Circuit Court of Appeals, the four United States District Courts within the State of New York, the New York Court of Appeals, and the lower courts of the State of New York. It has arranged those opinions by court in strict chronological order without volume divisions. The opinions are stored on the New York Product CD-ROM discs in that order, and that is "also the order in which they would be seen by a user who for some reason browses through the discs without sorting the case reports in a search." 158 F.3d at 697, Pet. App. 6a.[2]

West, by contrast, definitionally has selected for inclusion in its reporters only published opinions and it includes cases from jurisdictions outside New York.[3] West, moreover, does not arrange cases in strict chronological order and divides them by advance sheets and then bound

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[1] The two products arrange the text of each given judicial opinion in an entirely different manner as well. 158 F.3d at 705 n.20, Pet. App. 28a n.20 ("West does not claim that the appearance or layout of the cases on Bender's product reproduces the appearance or layout of West's case reporters. In fact, the layout is quite different.").

[2] West's Petition repeatedly invokes the pretense that Bender's New York product contains a "pre-programmed arrangement" that replicates the arrangement in West's reporters. *See, e.g.*, Pet. 6, 24. That assertion is untrue, as is evident from the undisputed record that Bender's New York Product stores and displays a different arrangement. 158 F.3d 697, Pet. App. 6a.

[3] West's Petition suggests that Bender's New York Product copies West's selection of cases. That assertion is untrue and West failed to raise it below. 158 F.3d at 700 n.11. Pet. App. 14a n.11 ("[T]his opinion will not address any copying by plaintiffs of the *selection* of cases included in West's case reporters. First, West argued below that Bender had copied West's arrangement of cases, not its selection. Second, it is uncontested that plaintiffs' compilations include many more opinions than West's case reporters.") (emphasis original).

volumes. 158 F.3d at 696-97, 700 n.11, 705 n.21. Pet. App. 4a-5a, 14a n.11, 28a n.21.

In sum, the arrangement of cases in Bender's New York Product simply does not copy West's arrangement of cases. 158 F.3d at 702, Pet. App. 19a ("If one browses through [Bender's] CD-ROM discs from beginning to end, using the computer software that reads and sorts it, the sequence of cases owes nothing to West's arrangement.").

For each opinion in the New York Product that is also published in a West reporter, Bender has added citation information—facts about the location of parallel text in West's reporters.[4] At the beginning of the opinion, Bender provides "parallel citations," information about the volume and first page number on which the case appears in the West reporter. For example, Bender would use "158 F.3d 693" as the parallel citation stating where the Second Circuit's opinion in this case begins in West's *Federal Reporter*. In addition, Bender provides information about the location of page breaks and corresponding page numbers within a given judicial opinion via the convention of "star pagination," *e.g.*, Bender would insert "[158 F.3d 696]" at the appropriate location in the opinion to indicate the location of the page break occurring immediately before the page in *Federal Reporter, 3d Series* that contains the text from the Second Circuit's opinion stating: "under a proper reading of the Copyright Act, the insertion of star pagination does not amount to infringement of West's arrangement of cases."

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[4] Providing citation information to a parallel source is a familiar convention of print reporters. For example, West's *Supreme Court Reporter* provides comprehensive parallel citations and star pagination to the *United States Reports*; West's *New York Reporter* provides comprehensive parallel citations and star pagination to Lawyers Cooperative's *New York Reports*; West's *California Reporter* provides comprehensive parallel citations and star pagination to Bancroft Whitney's *California Reports*.

West concedes that Bender's use of parallel citations is a non-infringing fair use. 158 F.3d at 700, Pet. App. 16a ("West concedes that insertion of parallel citations . . . to West's case reporters in plaintiffs' products (as well as any other compilations of judicial opinions) is permissible under the fair use doctrine."). But West claims that Bender's use of star pagination—factual information about the location of the page breaks—infringes West's copyright by allegedly reproducing West's arrangement of cases. 158 F.3d at 695-96, Pet. App. 3a.

Because West's infringement claim rides entirely on star pagination references to numbers corresponding to page breaks, it is critical to appreciate the following:

> West concedes that the pagination of its volumes—*i.e.*, the insertion of page breaks and the assignment of page numbers—is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process. As Judge Martin noted, "where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler."

158 F.3d at 699, Pet. App. 12a. Star pagination, which conveys factual information about the location of page breaks and corresponding page numbers, in sum, states a fact about an aspect of West's reporters that is even more devoid of "authorship" than the margins that surround the text or the size of the type font on the page.

When Bender commenced production of the New York Product, it possessed an apprehension that it would be sued by West were it to add star pagination to the product. That apprehension was based in part on *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987) (hereinafter, "*West v. Mead*"), a suit in which West sued

Mead Data Central, then owner of LEXIS-NEXIS,[5] for allegedly infringing West's copyright by adding star pagination to cases in the Lexis database. Bender's apprehension also arose from explicit threats of litigation made by West representatives to Bender employees in order to dissuade Bender from using star pagination, and from six other cases West filed between 1988 and 1993 claiming copyright infringement in connection with the use of star pagination. *See Matthew Bender & Co. v. West Publ'g Co.* 39 U.S.P.Q.2d 1079, 1084-85 (S.D.N.Y. 1996). To eliminate the cloud created by West's threats, Bender initiated this suit in 1994 to obtain a declaration that its use and intended use of star pagination to West's reporters would not infringe any West copyright.

C. The Decisions Below

On November 22, 1996, the district court granted Bender's motion for summary judgment on its copyright claim and denied West's cross-motion for summary judgment.

> [Copyright] protection extends only to those aspects of the compilation that embody the original creation of the compiler.[¶] Here, the original creation of West is not in the number of lines in any case, it is not in the number of pages of any case. The original

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[5] LEXIS-NEXIS is now indirectly owned by Reed Elsevier plc, which also recently acquired Bender. In opposition to the Petition, HyperLaw speculates that "the instant Petition may not involve an actual case or controversy between West and Matthew Bender." HyperLaw Brief in Opposition at 12. Without any evidentiary basis, HyperLaw imagines that as a result of the acquisition by Reed Elsevier, Bender "must now modify its position on the copyrightability of pagination," from which it draws "an inference that West and Matthew Bender have reached a partial resolution of the issues in the instant Petition without disclosing it to the Court or the courts below." *Id.* at 14. These baseless speculations about matters not of record are false. As Bender's request for summary affirmance and the arguments herein should make evident, Bender's position on the merits is unchanged and the actual controversy that impelled this lawsuit remains very much alive.

> creation *may be* in the way West selects cases for reporting, the cases that it puts, any headnotes that it adds to the report and similar additional material when put together with the official report that they obtain from the Court.[¶] However, where and on what particular pages of the text of a court opinion appears does not embody any original creation of the compiler, and, therefore in my view, is not entitled to protection.

Matthew Bender & Co. v. West Publ'g Co., 41 U.S.P.Q.2d at 1329-30. Pet. App. 78a-79a (emphasis added).[6]

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[6] West's Petition contains several inaccurate assertions regarding the decision. The court did not assume that "West's original case arrangement is protected by copyright." Pet. 7. Rather, the court assumed *arguendo* that a given volume of *Federal Reporter*—when considered *as a whole*, as opposed to based on arrangement alone—would be entitled to a compilation copyright. The court nowhere specified which elements in the totality of the compilation—headnotes, syllabi, key numbers, on the one hand, or arrangement, on the others—justified its assumption of copyright protection. 41 U.S.P.Q.2d at 1321, Pet. App. 49a ("[F]or the sake of this argument, we can take it [as] assumed that when West puts together a volume of the *Federal Reporter* there is a compilation that is entitled to protection.").

Similarly, the court did not assume that "a photocopy of a West volume would 'violate West's copyright' *by copying its original selection and arrangement*." Pet. 7 (emphasis added). Having made no assumptions about the copyrightability of West's selection and arrangement, the court merely stated that "if Matthew Bender took a volume of F.3d, ran it through its xerox machine or its computer and printed it out and called it Bender's Federal Third Reporter, that would violate West's copyright." 41 U.S.P.Q.2d 1321, Pet. App. 49a-50a. Again, the court merely assumed that the totality of West's work was protected, a proposition that Bender has never contested.

Finally, the court never assumed that Bender's product "can display West's original selection and arrangement with a minimum of user effort." Pet. 7. It was West's counsel, not the Court, that argued that Bender's product could be used to "recreate" a West volume; not even he asserted that this laborious project involved minimal effort, as the record belies any such claim. 41 U.S.P.Q.2d at 1323, Pet. App. 55a; 158 F.3d 696 n.5, Pet. App. 7a n.5.

On November 23, 1998, the Second Circuit affirmed. After reciting the fundamental rule under *Feist Publications, Inc. v. Rural Tel. Service Co.*, 499 U.S. 340 (1991) (hereinafter, "*Feist*"), that "copyright protection in compilations 'may extend only to those components of a work that are original to the author,'" 158 F.3d at 699, Pet. App. 12a, the Second Circuit held:

> Because the internal pagination of West's case reporters does not entail even a modicum of creativity, the volume and page numbers are not original components of West's compilations and are not themselves protected by West's compilation copyright. *See Feist*, 499 U.S. at 363, 111 S. Ct. at 1297 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.")[¶] Because the volume and page numbers are unprotected features of West's compilation process, they may be copied without infringing West's copyright.

Id. at 699, Pet. App. 12a-13a.

The Second Circuit found an idependent basis for its holding in the "fundamental distinction under the Copyright Act between an original work of authorship and the physical embodiment of that work in a tangible medium." *Id.* at 699 n.9, Pet. App. 12a n.9. Applying that dichotomy to the facts, it held that page breaks are merely a "feature[] of the physical embodiment of the work" not an "element of West's compilation," and are therefore not subject to copyright protection. *Id.* In other words, it found that the page breaks and corresponding page numbers of West's volumes are not a part of West's *work*, and thus not even potentially the subject of copyright protection, but rather are an accidental feature of the *physical object in which the work has been embodied.*

The Second Circuit considered and rejected West's argument that the embedding of star pagination in Bender's New

York Product enables a user to "perceive" West's arrangement through the aid of a machine and that this amounts to creating a "copy" of West's reporters under 17 U.S.C. § 101's definition of "copies." The court observed that the "sole purpose of § 101's definition of the words 'copies' and 'fixed' is to explicate the 'fixation requirement,' *i.e.*, to define the material objects in which copyrightable and infringing works may be embedded and to describe the requisite fixed nature of that work within the material object." *Id.* at 702, Pet. App. 21a. It noted that the definition was crafted to overrule the effect of *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908), which held that a piano roll was not a "copy" of the music it embodied because the perforations in which the music was fixed were unintelligible to the human eye. Section 101's definition clarified that the fixation requirement is met by objects embodying works capable of being perceived with a machine. *Id.* at 703, Pet. App. 23a.

Th Second Circuit held that under Section 101's definition of "copies," Bender's New York Product was a "copy," but of "the (non-West) sequence that is embedded on [its] CD-ROM discs and that appears with the aid of a machine without manipulation of the data," *i.e.*, a strictly by-court chronological arrangement. *Id.* at 703, Pet. App. 24a. Comparing the allegedly infringing "copy" embodied in Bender's New York Product with West's allegedly infringed reporters, the Second Circuit determined that no "substantial similarity" existed:

> West's case reporters contain many fewer cases than plaintiffs' CD-ROM discs, and are arranged according to classification such as court, date, and genre (opinions, per curiam opinions, orders, etc.), subject to certain exceptions characterized by West as features of originality, whereas plaintiffs organize their cases simply by court and date. Comparison of the works reveals that the cases that appear adjacent in

> the West case reporters are separated on plaintiffs' products by many other cases; and even if these other cases are disregarded, the West cases included on plaintiffs' products are not in an order at all resembling West's arrangement.

Id. at 705, Pet. App. 28a.

The Second Circuit rejected West's interpretation of § 101's definition of "copies" because it would mean that a given CR-ROM is a "copy" of "all arrangements and *re*-arrangements that could be made by a third-party user who manipulates the data [in it] on his or her own initiative." 158 F.3d at 703, Pet. App. 24a (emphasis original). The Second Circuit observed that West could "cite no case supporting its interpretation of § 101's definition of 'copies,' and every case we have found has relied upon the definition solely to ascertain whether a work has met the fixation requirement, not to determine the arrangements and rearrangements of the work fixed on the material object." *Id.* at 704, Pet. App. 24a-25a.

The Second Circuit further found that even if, *arguendo*, one accepted West's interpretation of "copies," there was no infringement because West admitted both (i) Bender's insertion of parallel citations is a non-infringing fair use; and (ii) using parallel citations alone, a user of Bender's product could create a lawful copy of West's arrangement as West defines "copies." The only incremental data perceivable through star pagination are facts about the locations of page breaks, which are not part of West's arrangement, do not constitute original expression, and which therefore may be lawfully copied. *Id.* at 701, Pet. App. 16a-18a.

Judge Sweet, sitting by designation, dissented. In his view, the Second Circuit should have followed the reasoning of the Eighth Circuit in *West v. Mead* and *Oasis Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996) (hereinafter, "*Oasis*"). 158 F.3d at 708, Pet. App. 38a.

ARGUMENT

I. THE WRIT SHOULD BE GRANTED AND THE DECISION BELOW SUMMARILY AFFIRMED SO THAT WEST CAN NO LONGER CLAIM A "SCARECROW" COPYRIGHT IN PAGINATION ANYWHERE IN THE UNITED STATES

A. Overview

Bender agrees that this case of national importance merits granting the writ of *certiorari*. Bender disagrees with West, however, not only about the merits—the Second Circuit opinion deserves summary affirmance—but also regarding what makes this case worthy of *certiorari*.

This case concerns whether using star pagination to parallel sources of judicial opinions constitutes copyright infringement. The proper resolution of this question is of vital interest to the bench, bar and public. Indeed, it is an issue of sufficient import that it has repeatedly and consistently attracted the efforts of the United States—through proposed amendments to the Copyright Act, antitrust litigation, and *amicus* participation in star pagination litigation—to bring about nationally the result reached below in the Second Circuit. *United States v. Thomson*, 949 F. Supp. 907, 925 (D D.C. 1996) ("The United States has consistently maintained that the use by others of star pagination does not constitute copyright infringement."). *See* Section I.C *infra*.

To appreciate the importance of star pagination, and the destructive effect wrought by West's copyright claim, one need only reflect how deeply citations to West's reporters are embedded in our legal practice. They form part of the fundamental grammar by which we communicate about law. *Cf.* Gary Wolf, *Who Owns the Law?*, 2.Q5 Wired Magazine 98, 138 (May 1994), available at http://www.wired.com/wired/archive/2.05/the.law.html ("Citations fulfill an intrastructural role in legal circles which is simi-

lar to that of currency in a modern society. . . . Just as the currency system allows financial transactions to occur, so the system for citing law materials facilitates information exchanges.") (citation omitted). Judicial opinions, secondary literature and attorney work product overflow with references to judicial text in the form of citations to West's reporters. Simply put, that is how judicial authority is cited. For a copy of an opinion to be citable in that form —as law, custom and practice demand—it is imperative for it to contain information concerning which volume, and on what pages, the opinion is located in West's reporters. *Id.* at 138 ("Any publisher is free to compile collections of federal decisions, but without citable page numbers these collections are little more than worthless."). *See* Section I.B.1, *infra.*

Because of the critical importance of citation information, West has asserted a copyright interest in its pagination for the purpose of preventing others from disseminating judicial opinions in a citable form. As the district court stated: "What West is attempting to do by trying to inhibit star pagination is to create a monopoly over reported court decisions." 41 U.S.P.Q. at 1330, Pet. App. 79a. Armed with its Eighth Circuit victory in *West v. Mead* under the "sweat of the brow" doctrine, in its continued claim of copyright after *Feist,* and its massive litigation resources, West has succeed in using its claim of star pagination copyright to chill the development of legal publishing. *See United States v. Thomson*, 949 F. Supp. 907, 925 (D.D.C. 1996) ("As reflected throughout its complaint, the government was concerned that West's copyright claim and its refusal to issue any licenses would impede entry into the markets affected by the merger [between West and Thomson], particularly emerging electronic forms of enhanced primary law and secondary law products."); *see also* Testimony of Kathryn Downing, President & COO Thomson Electronic Publishing, Subcommittee on Intellectual Property, *Hearings on H.R.*

4426, Serial No. 105, at 92 (May 14, 1992) (hereinafter "*Hearings*") (*West v. Mead* "has made it commercially impossible for Thomson or anyone else to publish, with page number citations, the decisions of the lower federal courts."); [7] *Who Owns the Law?, supra* at 138 ("West's provisional victory in [*West v. Mead*] has kept other electronic publishers at bay."); *Matthew Bender Takes On West Publishing's Copyright*, 2 Information Alert, Vol. 2 (February 11, 1994) ("It seems so silly—almost a joke —the notion that a company can hold monopoly control over such items as page numbers. But don't ever tell that to West Publishing Co. West takes very seriously, even religiously, its copyright on its federal reporters, including the page numbers."); Susan Hansen, *Fending Off the Future*, American Lawyer 74, 75 (September 1994) ("West's lawyers have earned a reputation for menacing letters and quick-strike lawsuits, hunting down infringers from coast to coast. One by one, 'copyists' as [West's president] likes to call them, have been marched into court and crushed."). *See* Section I.B.2, *infra.*

The Second Circuit has dubbed a dubious intellectual property right used to menace competitors a "scarecrow." *See Wembley, Inc. v. Superba Cravats, Inc.*, 315 F.2d 87, 98 (2d Cir. 1963). Through this case, Bender has attempted to reveal West's pagination claim for what is—a "scarecrow" copyright that, on examination, is baseless. The ruling below takes an imporant step towards eradicating West's pernicious "scarecrow" copyright claim. But if this Court declines to review the Second Circuit's decision, West will be able to continue to use *West v. Mead* coupled with artful litigation tactics to intimidate legal publishers from disseminating citable judicial opinions. The losers

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[7] Thomson subsequently acquired West. Apparently, it simultaneously acquired West's views on star pagination. *See* Vera Titunik, *That Was Then, This Is Now*, American Lawyer 21 (April 1996) (quoting Thomson's general counsel Michael Harris as saying "We believe star pagination is copyrightable.").

under that senario would be the public, the intended beneficiaries of copyright law. Legal publishers (other than Bender and HyperLaw) would continue to face the Hobson's choice of paying West fees for the right to copy what is in the public domain or facing costly and protracted litigation against West—potentially in the Eighth Circuit, where West has successfully parlayed its star pagination claims into something approximating post-*Feist* enforceability. *See* Section I.B.2(b), *infra.*

Only by affirming the Second Circuit's ruling now can this Court eliminate the *in terrorem* effect of West's "scarecrow" copyright claim. By granting *certiorari* and affirming the decision below, this Court will terminate, once and for all, West's assertion of a baseless (and highly anti-competitive) copyright claim by drawing the correct line between copyright and an endangered free market in the judicial opinions that constitute the law of the land.

B. Review Is Needed To Create Clear National Uniformity Regarding The Copyrightability Of Star Pagination

1. *The Importance Of Star Pagination*

Citations to West's reporters[8] are ubiquitious in the state and federal *corpus juris*, submissions to the courts, and the vast secondary literature about our laws. Information about the location of page breaks in West reporters

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[8] West has long been this nation's dominant publisher of judicial opinions of the federal and state courts. Its federal reporters, which are the only comprehensive collection of published decisions of the U.S. district courts and the courts of appeals in book form, are the *de facto* official reporters of the lower courts. *See, e.g.*, 1 F. Cas. iii (1894) (West refers to itself as "the official Reporter of the Federal Courts."); L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 U.C.L.A. L. Rev. 719, 727, n.21 (1989) ("As to the federal judiciary, West operates as the functional equivalent of an official reporter for all courts below the Supreme Court.") (citing numerous local rules).

has thus become a standard frame of reference for discussion, debate and advocacy about the law of this country. 158 F.3d at 696, Pet. App. 4a-5a ("universally cited by the volume and page number of the case reporter series in which they appear"). In fact, many courts mandate, whether through local rules or judges' individual rules of practice, that citations in briefs be to the apropriate volume and page number of West's reporters. *See, e.g.*, Third Cir. R. 28.3(a); Eleventh Cir. R. 28-2(k). Legal citation manuals similarly require citation to West's reporters. *See, e.g., The Bluebook: A Uniform System of Citation* 165-67 (16th ed. 1997).

When a copy of a judicial opinion is published in a non-West source whose publisher wishes to be linked to the vast web of citations to West's reporters,[9] that copy of the judicial opinion must include parallel citations and star pagination. Absent these capabilities, that copy of the judicial opinion will be unusuable to generate citations in proper form or to evaluate the authority cited by others.

2. *West's "Scarecrow" Copyright In The Eighth Circuit*

From the foregoing considerations, there can be no doubt of the necessity for citations to West reporters, and the necessity of including them in copies of opinions if the publisher of those copies has any hope to make them usable. The opinion below secures that right to Bender and HyperLaw. Nonetheless, West's "scarecrow" copyright exerts continued vitality.

The source of this mischief is the Eighth Circuit's pre-*Feist* ruling, via a divided panel, in *West v. Mead*. With-

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9 West is now part of West Group, a division of The Thomson Corporation. West Group also includes, *inter alia*, Lawyers Co-operative Publishing Company, Bancroft-Whitney Company, Banks-Baldwin, Clark Boardman Callaghan. West Group publishers are responsible for publishing many states' (e.g., California and New York) "official" reporters. *See* About West Group, http://www.westgroup.com/newsinfo./aboutwg/Welcome.html

out question, the Second Circuit majority reached a ruling below at odds with that case. However, as developed below, West mischaracterizes the legal import of this doctrinal clash as a "paradigmatic" circuit split, and petitons for *certiorari* on that basis. Although West overstates the extent to which a circuit split exists as a matter of law, it must be acknowledged that West's ability to make continued headway against other publishers based on *West v. Mead* has, *as a practical matter*, the same real-world impact of a split. West's potential offensive use of *West v. Mead* continues to stifle competiton and deform copyright doctrine in a way that demands redress from this Court.

(a) *The Nature Of The Conflict*

West is wrong to posit a true circuit split. *West v. Mead* reviewed the grant of a preliminary injunction on a record devoid of evidence as to whether West's pagination "is nothing more than an electronic response to a direction given a machine or whether, as a mater of fact, West's new pagination may be considered an original work of authorship." *West v. Mead*, 799 F.2d at 1237 (Oliver, J., dissenting).[10] Its holding was tentative. 799 F.2d at 1229 ("our observations as to the governing law made in this opinion[] are tentative and provisional, in the sense that different findings or conclusions might be warranted after a trial on the merits.") (internal quotations omitted); *see also University of Texas v. Camenisch*, 451 U.S. 390, 395 (1981) ("the findings of fact and conclusions of law made by a court granting a preliminary injunction are not binding at trial on the merits."). Accordingly, *West v. Mead* does not carry the same precedential weight as an appellate panel review of a final judgment—such as this

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10 This case resolved that critical question: "West concedes that the pagination of its volumes—i.e., the insertion of page breaks and the assignment of page numbers—is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process." 158 F.3d at 699, **Pet. App. 12a.**

case—and therefore does not create a full-blown circuit split.[11]

(b) *The Continued Specter Of* West v. Mead

The Second Circuit rightly condemned *West v. Mead* as bad law after this Court's *Feist* decision unanimously abolished the "sweat of the brow" line of authorities pursuant to which *West v. Mead* had extended copyright to pagination. *See* 158 F.3d at 708, Pet. App. 36a ("At bottom, *West Publishing Co.* [*v. Mead*] rests upon the now defunct 'sweat of the brow' doctrine."); *see also United States v. Thomson*, 949 F.Supp. at 926 ("this Court has serious doubts about the continuing vitality of the Eighth Circuit's 1986 opinion in *Mead Data* in view of the subsequent decision of the Supreme Court in *Feist*.").

Critics of *West v. Mead* have included the United States, which has particpated as *amicus curiae* in this case and in *Oasis*, the Register of Copyrights, who is the senior official of the United States government charged with the formulation of copyright policy, and copyright scholars. *See* Brief for Amicus Curiae United States in Support of Appellees at 5, available at http://www.usdoj.gov/atr/cases/fl100/1191.htm ("*Mead* itself has been fatally undermined by *Feist*. *Mead's* conclusion regarding copying rests on the 'sweat of the brow' theory of compilation copyright, which *Feist* squarely rejected."); Testimony of Ralph Oman, Register of Copyrights, *Hearings* at 6

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[11] Before the Eighth Circuit, West itself acknowledged as much in its appeal of *Oasis:* "West did not argue in the Court below that [the Eighth Circuit's] decision in *West v. Mead*, which arose on an appeal from entry of a preliminary injunction, was binding on the District Court." Appellee West Publishing Company's Brief at 6, *Oasis Publ'g Co v. West Publ'g Co.*, No. 96-2887 (8th Cir., filed October 8, 1996). Were it not for the limited precedential nature of *West v. Mead*, that case would have been binding not only on the *Oasis* district court, but on the Eighth Circuit too. *See Ramsey v. Bowersox*, 149 F.3d 749, 760 (8th Cir. 1998) ("One panel of this court is bound by the decisions of other panels.").

("*Mead* . . . was a substantial departure from existing precedent. . . . Even if the eighth circuit's decision were consistent with existing law, *Feist* tolled the death knell for creations based exclusively on sweat-of-the-brow instead of on originality."), 1 Melville Nimmer & David Nimmer, *Nimmer on Copyright* § 3.03 (1999) (*West v. Mead* "extends compilation copyright too far."); 1 William F. Patry, *Copyright Law and Practice* 660 n.595 (1994) (*West v. Mead* "was bad law before *Feist*, . . . and in light of *Feist*, which firmly established originality and infringement of expression as the bases of copyright, it should no longer be cited as precedent even in the Eighth Circuit."); 1 Neil Boorstyn, *Boorstyn on Copyright* § 2.16[1] (1999) ("*Mead* protected West's page numbers because West spent so much labor and industry in compiling them. The Supreme Court has effectively overruled *Mead* on this point."); L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 U.C.L.A. L. Rev. 719, 813 (1989) (*West v. Mead* was "wrongly decided in terms of the copyright clause of the Constitution, the case law, and the Copyright Act of 1976."); [12] *see also* Arthur R. Miller, *Copyright Protection for Computer Programs, Databases, and Computer-Generated Works: Is Anything New Since CONTU?*, 106 Harv. L. Rev. 978, 1041 n.284 (1993) ("*Feist* raises questions concerning the continued viability of such cases *West Publishing Co. v. Mead Data Central, Inc.*, . . . which held that star pagination was copyrightable.").

Notwithstanding the tentative nature of *West v. Mead* and the blistering criticism it has drawn, the opinion has continued to enjoy post-*Feist* vitality in the Eighth Circuit. A district judge in Minnesota recently followed it stating,

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[12] This Court in *Feist* favorably cites six times to the Patterson and Joyce article, which is a 150-page critique of *West v. Mead*. 499 U.S. at 347, 348-49, 351, 361-62.

"*Feist* did not overrule *Mead*." *Oasis*, 924 F.Supp. at 923; *see also* 158 F.3d at 711, Pet. App. 44a (Sweet, J., dissenting) ("I subscribe to [the *Oasis* court's] view of the interrelationship between *West* [*v. Mead*] and *Feist*."). If, as seems reasonably likely, other district courts in the Eighth Circuit follow the lead of *Oasis*, West will be able to continue to perpetuate *West v. Mead* by litigating its "scarecrow" copyright in the Eighth Circuit, and settling (or mooting) after obtaining favorable lower court rulings.[13] By so doing, West will be able to deny the Eighth Circuit the opportunity to reexamine *West v. Mead* and West will thereby extend its "scarecrow" copyright claim.

In sum, a split of authority now exists as a practical matter. Through selective enforcement of its copyright

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[13] It is precisely this strategy that West followed in *Oasis*. Oasis Publishing brought a declaratory judgment action against West in the Southern District of Florida. West moved to dismiss for lack of a justiciable controversy, and moved in the alternative to transfer the case to the District of Minnesota. West's motion to dismiss was not ruled on, but its motion to transfer was granted. Once in Minnesota, West dropped its jurisdictional argument. *Oasis*, 924 F. Supp. at 921. Then, after achieving a district court decision endorsing the continued vitality of *West v. Mead*, West settled the case, paying the loser, Oasis Publishing, attorney's fees and granting Oasis a star pagination "license." West thereby effectively preserved the favorable result it had obtained and prevented the Eighth Circuit from reevaluating *West v. Mead* in light of *Feist*.

As a related strategy, West attempted to avoid the Second Circuit's jurisdiction in this case. It asserted in an early filing that there was no personal jurisdiction over West in the Southern District of New York because West was not doing business there. West subsequently attempted to moot the controversy before summary judgment by promising not to sue Bender for the initial version of the New York Product. West was unwilling, however, to represent that it would not sue Bender over subsequent versions (including the existing second version), and the court rejected West's mootness gambit. *See* 39 U.S.P.Q.2d 1079, 1086 (1996). West also moved unsuccessfully to dismiss the case for alleged lack of a justiciable controversy, claiming that Bender did not have the intent or ability to manufacture (the now commercialy available) New York Product or possess a reasonable apprehension that West would sue Bender for adding star pagination to it. *See id.* at 1084-85.

and strategic settlements, West has in the past and will in the future be able to insulate a bad Eighth Circuit ruling from correction. The upshot is to leave all parties other than Bender and HyperLaw vulnerable to West's litigation juggernaut.

C. This Case Furnishes The Appropriate Vehicle To Vindicate The Repeated Efforts By The United States To Make Star Pagination Available To All

For many years, the officials of the United States entrusted with refining and enforcing our nation's copyright and antitrust laws have endeavored to overcome *West v. Mead* and to put an end to the ill effects caused by West's fantastic claim of copyright protection in the pagination of its reporters. In other words, the United States has labored consistently to ensure, in effect, that the result in this case becomes the law of the land. A grant of *certiorari* and affirmance constitute the only means at present to bring those efforts to fruition.

1. *The Copyright Office's Efforts To Amend The Copyright Act To Clarify That Star Pagination Is Not An Infringement*

The first attempt by the United States to right the wrong inflicted by *West v. Mead* took place in 1992, when the United States Copyright Office supported a bill to amend the Copyright Act to clarify that citation information is not protected by copyright.[14] The Register of Copyrights explained the Copyright Office's support for the legislation:

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[14] Ironically, the bill was introduced through the efforts of The Thomson Corp., West's current owner, whose representative then testified that the legislation was necessary to "overrule the West [v. Mead] decision and enable Thomson and others to publish . . . primary legal texts." *Hearings* at 91. West attacked the bill as a foreign plot. *See* Prepared Statement of Vance Opperman, *id.* at 159 ("Perhaps more disturbing is the motive of the primary proponent of H.R. 4426, Lord Thomson and his foreign-based Thomson conglomerate. We have all witnessed past efforts by foreign firms, acting under the guise of the U.S. subsidiaries they have

> [The] bill would clarify that public domain elements like case names, numbers, citations, and volume and page numbers are meant to be freely accessible and not subject to proprietary rights that might inhibit commercial copying. The Copyright Office supports the general principle of this bill that copyright should not be available to protect these elements.
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> * * * *
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> The *Mead Data* decision was a substantial departure from existing precedent. The court applied equitable and sweat-of-the-brow considerations and some inherent notions of unfair competition relief to give protection against copying. . . . Even if the eighth circuit's decision were consistent with existing law, *Feist* tolled the death knell for creations based exclusively on sweat-of-the-brow instead of on originality. The Constitution requires an element of originality before copyright protection will kick in.

Hearings at 6. As evidenced by the instant suit, that bill never passed the full Congress.[15]

2. *Antitrust Enforcement Efforts To Force West To Make Star Pagination Available To All*

The United States, together with seven states, filed an antitrust suit challenging The Thomson Corp.'s acquisition of West. The complaint in that case identified West's "scarecrow" copyright claim as an improper barrier to competition:

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bought up, to alter or dismantle fundamental American laws for their own profit and at the expense of American jobs and prosperity.").

[15] Efforts against it were spearheaded by West and Rep. James Ramstad, the Minnesota Congressman who represents the district in which West is headquartered. *See* Testimony of James Ramstad. *Hearings* at 5 ("The legislation being considered today represents an effort by one of the largest and most powerful foreign conglomerates in the world, led by an English lord, to win in the U.S. Congress what it knows it cannot win in the courts.").

> West claims that a copyright is infringed by use of what is commonly referred to as "star pagination," the insertion of symbols in the text of decisions to indicate where internal page breaks are in West's National Reporters System, and the placement nearby of the corresponding West reporter's page number. West has granted few, if any, licenses to employ star pagination to anyone other than Lexis-Nexis. Thus, existing or potential participants in the markets for primary law products cannot offer products with star pagination without the threat of costly infringement litigation. Because citations to the National Reporter System are commonly required or expected by courts, and thus sought by users, West's copyright claim chills potential entry into these markets.

Complaint For Injunctive Relief, *United States v. Thomson Corp.*, No. 96-1415 (PLF) at ¶ 32, available at http://www.usdoj.gov/atr/cases/f0700/7.30.htm; *see also id.* at ¶43 ("Particularly for CD-ROM products, where it is possible to include both primary and secondary law products on the same CD-ROM, the ability to include star pagination is an important competitive factor.").

To settle the case, Thomson and West offered to make available a form license for star pagination. Several aspects of this arrangements troubled the court, not the least of which was that the very fact of including a star pagination "license" in the Final Judgment could be construed "as an endorsement of West's dubious copyright claim." *United States v. Thomson*, 949 F.Supp. 907. To disabuse the public of that notion, the United States added disclaimer language to the Final Judgment. *Id.* at 907 n.19.

The court also found unacceptable that West included in the original form license a provision pursuant to which anyone taking out the license had to agree that it would never challenge West's "scarecrow" copyright in pagination. Only when the court let it be known that no Final Judgment in such an overreaching form would bear its

imprimatur did West accede to the elimination of that Faustian clause. 949 F. Supp. 929 n.20.

Finally, the Court found troubling the fact that West would be able "to profit from its dubious copyright claim while maintaining by court order significant barriers to entry into the relevant markets identified in the complaint by smaller publishers, particularly in the CD-ROM market." *Id.* at 929. Finding that charging license fees for star pagination lay "beyond the reaches of the public interest," *id.* (citation omitted), the court suggested a remedy whereby West would agree to provide "a free license to all who requested one until West's copyright claim is judicially resolved once and for all." *Id.*

In response to the court's ruling, West and Thomson proposed an alternative licensing scheme pursuant to which all fees for star pagination "would be deferred until either a 'final judicial determination' of the merits of West's copyright claim has been made or December 31, 2000, whichever comes first." *United States v. Thomson,* 42 U.S.P.Q.2d 1867, 1869 (D.D.C. 1997). The court, in adopting that proposal, stated that "a final judicial determination is a Supreme Court decision on the merits. A denial of certiorari would not constiute a final determination. Nor would a majority or, even unanimity, in the circuits constitute such a determination." *Id.* at 1870.

Crucially for this Petition, the court ruled that only when the Supreme Court invalidated West's star pagination copyright claim—the very oportunity presented by this case—would the subject license fees be eliminated from the form license that the United States had negotiated with West to protect the public interest. Because the court thought that Supreme Court review of this case was a "likelihood," 949 F.Supp. at 907, and West's claim "dubious," *id.* it deemed deferred fees, that would ultimately be waived, an acceptable compromise.

3. *The United States'* Amicus *Participation In Star Pagination Cases In Favor Of Bender's Position*

It is unusual for the United States to participate as an *amicus curiae* in a copyright dispute between private parties at the appellate stage, much less while the case is still pending before a trial court. However, because the issues in this case are of signal importance to maintaining the proper equilibrium of our nation's intellectual property laws, the United States submitted *amicus* briefs in support of Bender's position before both courts below.[16] As it stated to the Second Circuit,

> The United States, which filed an amicus brief below, has a substantial interest in the resolution of the appeal. It has numerous responsibilities related to the proper administration of the intellectual property laws, as well as primary responsibility for enforcing the antitrust laws, which establish a national policy favoring economic competition. Accordingly, the United States has an interest in properly maintaining the "delicate equilibrium," . . . Congress established through the copyright law between protecting private ownership of expression as an incentive for creativity and enabling the free use of basic building blocks for future creativity.

Brief for Amicus Curiae United States of America in Support of Appellees at 1-2, available at http://www.usdoj.gov/atr/cases/fl100/1191.htm. Granting *certiorari* and summary affirmance present the oportunity to ensure that the United States' goal of maintaining copyright's "delicate equilibrium" will be realized for all. *Cf. generally* David Nimmer, Elliot Brown & Gary N. Frischling, *The Metamorphosis of Contract Into Expand*. 87 Cal. L. Rev. 17 (1999) (critiquing attempts to subvert via con-

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[16] The United States also filed an amicus brief in the appeal of *Oasis* advancing the same arguments as in this case. That brief is available at http://www.usdoj.gov/atr/cases/f0800/0860.htm.

tract the "delicate balance" set by the Supreme Court's copyright jurisprudence).

II. THERE IS NO NEED TO GRANT THE WRIT TO EXPLICATE THE COPYRIGHT ACT'S DEFINITION OF "COPIES" OR TO PROTECT WORKS FIXED IN CD-ROMS

Although this case presents issues of vital importance, West misleads when it suggests that this case poses "one of the most important copyright issues of the information era" and threatens to provide "would-be infringers of copyrighted compilations with complete insulation against liability, so long as they make their copy available digitally." Pet. 4. In truth, this case does not turn on "the nature of CD-ROM technology," Pet. 5, or involve "computer age 'loopholes' for infringers," Pet. 18. Nor does it have special implications for "electronic media," Pet. 4, "[c]omputers and other new telecommunications technologies," *id.* or "the ever-expanding universe of data." *Id.* We may be standing on the "brink of a new millenium," Pet. 4, but West's rhetoric aside, the questions that this case presents arise, and indeed have been litigated since the 19th Century, in the quintesentially low-tech posture of compilations of judicial opinions bound in books. *See Callaghan v. Myers,* 128 U.S. 617, 661-62 (1888) ("the paging of the book may depend simply on the will of the printer, of the reporter, or publisher, or the order in which the cases have been decided, or upon other accidental circumstances. . . . [T]he paging of the volumes is a labor inconsiderable in itself, and I regard it, not as an independent matter") (quoting *Myers v. Callaghan,* 20 F. 441, 442 (C.C.N.D. Ill. 1883);[17] *Banks Law Publ'g Co. v.*

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[17] Earlier in its analysis, the Court adverted in dicta to "the order of arrangement of the cases, the division of the reports into volumes, the numbering and paging of the volumes" as parts of the volume over which protection may potentially subsist. *Id.* at 649, 661. As scholarly commentary has noted, that "fleeting observation"

Lawyers' Co-operative Publ'g Co., 169 F. 386, 391 (2d Cir. 1909), *app. dismissed*, 223 U.S. 738 (1911) ("the arrangement of reported cases in sequence, *their paging* and distribution into volumes, are not features of such importance as to entitle the reporter to copyright protection of such details.") (emphasis added); *Eggers v. Sun Sales Corp.*, 263 F. 373, 375 (2d Cir. 1920) ("identity of pagination" in reprint of preexisting pubic domain materials "is not of sufficient importance to constitute infringement of copyright.").

The centerpiece of West's attempt to posture this case as being about electronic media is its eroneous interpretation and application of the statutory definition of "copies" in 17 U.S.C. § 101. As the Second Circuit noted, West's attempted use of the definition of "copies" is an unprecedented misreading of the language and purpose of that provision, one that ignores the provision's historical genesis. 158 F.3d at 703-4, Pet. App. 24a-26a.

The origin of Section 101's definition of copies is found in *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908), which held that a piano roll did not constitute a "copy" of the musical composition encoded into it, and that therefore the unauthorized manufacture of that piano roll did not infringe on plaintiff's "right to copy." For most of this century, that precedent meant that a work on which a subject composition was not visually perceivable did not infringe. *See* 1 *Nimmer on Copyright* § 2.03[B][1].

In 1976, Congress definitively rejected that case. *Id.* It did so by defining "copies" as "material objects . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, re-

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is "contradicted by other aspects of the Court's opinion . . . ." Patterson & Joyce, 36 U.C.L.A. L. Rev. at 744. West's argument that Second Circuit's ruling is in conflict with *Callaghan* is accordingly incorrect.

produced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 101. Congress thereby repudiated "the artificial and largely unjustified distinctions, derived from such cases as *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908)." S. Rep. No. 94-473, at 51 (1975): H.R. Rep. No. 94-1476, at 52 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5665 (1976).

In a legal universe governed by *White-Smith v. Apollo*, although it would constitute copyright infringement to make a photocopy of the entirety of the bound volumes of West's reporters, making an electronic copy of the entirety of those volumes (on CD-ROMs for example) would be non-actionable. By contrast, the 1976 Act mandates a different result. Under the current law, it is equally forbidden to reproduce the whole of a copyrighted work, whether in visually perceivable form (such as via a photocopy machine) or in machine-readable form (such as on a CD-ROM).[18] Thus, the claim that "West's original arrangements . . . have been denied protection from electronic copying," Pet. 5, is flatly wrong. If a copyrighted work is copied electronically, infringement liability follows. Nothing in the decison below casts the slightest doubt on that construction.[19]

Once the congruence under current law between literary works as embodied in CD-ROMs and as embodied in

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[18] Given the breadth of the definition of "copies" in 17 U.S.C. § 101, all but the most exotic examples of physical embodiment are now actionable under the Copyright Act. *See* 2 *Nimmer on Copyright* § 8.02[B][2] (writing in the sand before the oncoming tide too evanescent to satisfy statutory requirement of being "fixed"); Brandriss, *Writing in Frost on a Window Pane: E-Mail and Chatting on RAM and Copyright Fixation*, 43 J. Copyright Soc'y 237 (1996) (adducing example of writing in the frost that forms on a window pane).

[19] There is, accordingly, no substance to the charge that the Second Circuit failed "to reconcile CD-ROM technology with the 1976 Copyright Act." Pet. 9.

printed books is appreciated, West's attempt to posture this case as raising unprecedented technological issues collapses of its own weight. It is uncontested that the CD-ROMs that Bender produces are material objects that constitute a "copy" no less than do bound volumes. It is uncontested that an arrangement fixed in a CD-ROM could be substantially simlar to, and infringe, an arrangement protected by copyright that has been fixed in a book. But the arrangement that is "fixed" in Bender's New York Product is simply not the arrangement in West's reporters. Bender has no more "programmed [its] CD-ROMs so that a user can readily display all the cases from the West volume in the precise order—case by case, page by page—that they appear in West's bound volumes," Pet. 17, than have purveyors of bound books for the last century that include parallel citations. A customer who purchases a bound volume (*e.g.*, from West) into which the publisher has inserted parallel citations (even without star pagination) can, if so inclined, choose to read therein the cases in the exact order in which they are featured in the rival set referenced by the parallel citations.[20] The ruling below applies as directly to this potential use of books as it does to the potential use of electronic media.

CONCLUSION

Copyright protects works of original expression created by authors. The location of page breaks, and the corresponding page numbers in West reporters, are not original expression created by an author. Indeed, they do not even comprise an element of West's literary works, but

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[20] As noted above, West has long included star pagination and parallel citations to rival sources. *See* n.4 *supra*. Thus, a reader of any volume of *Supreme Court Reporter* could use that volume alone, by accessing its index and flipping its pages, to review all of the opinions contained in a parallel volume of the rival *Lawyer's Edition* compilation of Supreme Court decisions, *in the order in which Lawyer's Edition presented them.*

are instead accidental features of the tangible objects in which West has fixed its compilations. Star pagination references to those page breaks and their corresponding page numbers do not copy any element of West's works, much less an original, copyrighted element.

West has effectively used the *West v. Mead* decision and its progeny as a "scarecrow" to dissuade others from offering judicial opinons with star pagination references. As evidenced by the failed efforts to enact H.R. 4426, this problem is unlikely to be solved by legislation. As is evident from West's settlement of *Oasis*, it is unlikely that West will ever let the Eighth Circuit reexamine *West v. Mead* in light of *Feist*. Based on the United States' antitrust suit against West, a judical finding already exists that the public interest in avoiding onerous license fees for having access to unprotected materials awaits Supreme Court resolution. This case presents the one likely opportunity to create clear, uniform, nationwide law that citation information is not subject to copyright protection. Accordingly, Bender respectfully requests that *certiorari* be granted and that the Second Circuit's ruling be summarily affirmed.

Respectfuly submitted,

DAVID NIMMER
MORGAN CHU
ELLIOT BROWN
Counsel of Record
PERRY GOLDBERG
IRELL & MANELLA LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, California 90067
(310) 277-1010

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